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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	694231/0051 JJD:IGD	5110
32361 7590 05/18/2007 GREENBERG TRAURIG, LLP MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166			EXAMINER RETTA, YEHDEGA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/696,295	MORRISROE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/21/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to the amendment filed February 21, 2007. Applicant amended claims 5 and 6. Claims 1-28 and 31-33 are still pending.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by of Solbright White Paper; “The Inside Edge on Rich Media Partnership Series”; March 2001, (herein after Solbright).

Regarding claim 1, Solbright teach integrating an input file (Flash ad) and conduit file (tracking code) and creating an integrated file; serving the integrated ad file from a computer to provide the ad (see pp 17-19);

Regarding claim 4, Solbright teaches the use of Macromedia Flash; wherein the ad is Flash ad and the files are “swf” files (see pp 17 see also the sites for the “Macromedia’s Rich Media Tracking Kit” cited in White Paper, page 17)).

Regarding claims 7-10, Solbright teaches the ad including one or more actions for linking to one or more web pages where in the integrated ad file includes html code loading a JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file and tracking identifier; the html code including a variable and the conduit file includes code that

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determined where the ad opens in a parent window or new window based on the variable (see pp 18-20, see also [www.macromedia.com/solutions/richmedia/tracking/advertising\\_guide/](http://www.macromedia.com/solutions/richmedia/tracking/advertising_guide/)).

Regarding claim 33, Solbright teaches the ad is provided to a user computer via the Internet and combining of the files is in response to receiving a request for a Web page and serving the integrated ad file as par of the web page (see pp 17-20).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 11-28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solbright White Paper; “The Inside Edge on Rich Media Partnership Series”; March 2001, (herein after Solbright) in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, Solbright does not explicitly teach receiving a modified ad file or conduit file. Solbright teaches designers creating their ads and developers or programmers adding the tracking string after the ads are created. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the designer or programmers of Solbright would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.

Regarding claims 5 and 6, Solbright does not explicitly teaches the input file includes an empty movie object and inserting the conduit file in the empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name. However official notice is taken that well known in the art of movie clip create empty movie clip and to assign a predetermined name. It is well known to create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the empty clip as a placeholder for external file such as the tracking data, if the ad is a movie clip.

Regarding claims 11, 12, 15-21, 24-27, Solbright teaches identifying a first file (flash ad); identifying a second file (tracking information); wherein the first file specifies ad content code and the second file contains ad-tracking code; creating an ad file including computer code for providing the ad; wherein the first file specifies ad content code and the second file contains an ad-tracking code; html code loading ad file (third file); third file including one or more buttons; creating the (see pp 17-20). Solbright does not explicitly teach identifying a placeholder (an empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. However official notice is taken that is old and well known in the art of programming to create empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a

placeholder for external files such as the tracking data to be inserted in it, if the ad is a movie clip.

Regarding claims 31 and 32, Solbright teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 17-20).

### ***Response to Arguments***

Applicant's arguments, filed February 21, 2007, with respect to the rejection(s) of claim(s) 1-28 and 31-33 under "102" and "103" have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Solbright.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Developer Center Article; Macromedia Flash Ad Tracking Made Easy; Eric Picard;  
[http://www.adobe.com/devnet/rich\\_media\\_ads/articles/multitrack.html](http://www.adobe.com/devnet/rich_media_ads/articles/multitrack.html).

Introducing the MFAA and the Macromedia Tracking Kit; Bill McCloskey; January 24, 2001; [http://clickz.com/showPage.html?page=clickz\\_print&id=835731](http://clickz.com/showPage.html?page=clickz_print&id=835731).

A Brighter Flash, The Macromedia Flash Ad Alliance; Sandy Serva; Econtent; May 2001, 24, 3; ABI/INFORM Global.

DoubleClick Unveils New Features for DART to Streamline the Management of Rich Media Creatives; DoubleClick Rolls out Rich Media Vendor Certification Program; Business, Technology, Advertising & Media Editors; Business Wire. New York: Oct 15, 2001. pg. 1. <http://proquest.umi.com/pqdweb?index=0&sid=7&srchmode=1&vinst=PROD&fmt=3&startpage=-1&client>.


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Macromedia – Press Room, 2001; : Macromedia and WebSideStory Bring Real-Time Tracking and Analysis service to Macromedia Flash sites.  
<http://web.archive.org/web/20030608064019/www.macromedia.com/macromedia/proom/pr/2001/websidest>.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**RETTA YEHDEGA**  
**PRIMARY EXAMINER**